

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILHELM BRUGGER and JOHANN HABERL

Appeal No. 2000-2003
Application 08/477,878

ON BRIEF

Before CALVERT, McQUADE, and NASE, Administrative Patent Judges.
CALVERT, Administrative Patent Judge.

ORDER UNDER 37 CFR § 1.196(d)

This is an appeal from the final rejection of claims 1 to 3, all the claims in the application, which stand finally rejected under 35 U.S.C. 102(e) as anticipated by Levy et al (Pat. No. 5,346,489).

Requirement Under 37 CFR 1.196(d)

Pursuant to 37 CFR 1.196(d), this Board deems that it is appropriate for a reasoned decision on this appeal that appellants address the following matters:

- (1) In an Appendix A to the examiner's answer, the examiner shows how he considers that, in certain positions of the handpiece head 22 of Levy et al, the fiber (light guide) 52 would extend "increasingly eccentrically from the coupling toward the inner side of the bend," as recited in claims 1 and 3. Since appellants have not filed a reply brief, their position on this matter is not clear. Appellants are required to address the question of whether they agree with the examiner's analysis as set forth in Appendix A of the answer and the accompanying discussion, and if not, state the reasons for their disagreement.
- (2) Claims 1 and 3 both recite that the end of the light guide (claim 1) or the light guide (claim 3) is "rotatably mounted in the receiving means." This recitation appears to be contrary to the detailed description on page 8 of the specification, where it is stated at lines 6 and 7 that the light guide is "fixedly connected" to the receiving means, and therefore it is not clear

precisely what the scope of the claims is. Cf. In re Cohn, 438 F.2d 989, 993, 169 USPQ 95, 98 (CCPA 1971) (claims indefinite in view of inconsistency between claims and the supporting disclosure). It is necessary that appellants address this apparent discrepancy and that it be resolved prior to our rendering a decision on this appeal.

In reviewing the claims, we note that the handpiece recited in claim 3, having "the light guide extending through the handpiece to the head mirror," is not shown in the drawings as required by 37 CFR § 1.83(a). Also, the term "headpiece" in claim 3, line 11, has no antecedent basis in the specification. 37 CFR § 1.75(d)(1).

Time for Response

Appellants are required to file a response addressing matters (1) and (2) above within two months from the date of this paper. As provided in 37 CFR § 1.196(d), this time period is

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non-extendable. Failure to file a timely response will result
in dismissal of the appeal. See MPEP § 1212 (Feb. 2000).

IAN A. CALVERT)	
Administrative Patent Judge)	
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JOHN P. McQUADE)	
Administrative Patent Judge)	APPEALS AND
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